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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,070	08/06/2001	Hong Jin	7682-059-999	1768

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EXAMINER

LUCAS, ZACHARIAH

ART UNIT	PAPER NUMBER
	1648

DATE MAILED: 09/09/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/923,070	JIN ET AL.
	Examiner Zachariah Lucas	Art Unit 1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 23 June 2003.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 25-37 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
  - 5) Claim(s) \_\_\_\_\_ is/are allowed.
  - 6) Claim(s) \_\_\_\_\_ is/are rejected.
  - 7) Claim(s) \_\_\_\_\_ is/are objected to.
  - 8) Claim(s) 25-37 are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

***Supplemental Election/Restrictions***

1. This Supplemental Restriction Requirement is intended to clarify the standing restriction requirement.

2. Currently claims 25-37 are pending in the Application. These claims fall within Group VI of the original claim sets. However, as amended, these claims rely on a definition for the term heterologous that varies from the definition intended in the original restriction requirement, and the Applicant indicates that they read this definition as a linking claim joining all of the subgroups of Group VI as indicated below (copied from the original restriction). However, while the Applicant includes in the definition of a heterologous sequence modified versions of the native RSV genes, the restriction requirement requires an election of a specific gene from the RSV genome to be mutated, or the inclusion of a heterologous gene. By this, the restriction means an RSV including a gene not native to (or derived from such genes) the RSV which is being altered. Thus, if the Applicant elects the heterologous sequence of subgroup VI-6, the only claims that will be examined are claims 25 and 36.

It is noted that claim 25 is generic to all of the subgroups of Group VI. However, the claim will be examined only to the extent that it reads on the elected invention. Claim 27 (specifying that the heterologous sequence is a modification of the native sequence) is considered generic only to subgroups VI-1 to VI-5. This is because claim 25 reads on

heterologous sequences generally, while claim 27 is limited to modified forms of the native RSV.

3. In view of the changes made to the claims since the original restriction, and to clarify the restriction, the subgroups have been adjusted as indicated below (italics). If the claims are further amended to include other genes to be modified in some fashion, the Applicant may elect one of such genes rather than the genes identified below.

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:

VI. Claims 13-20, drawn to vaccines comprising chimeric RSV, the genome of which comprises the reverse complement of an mRNA coding sequence operatively linked to a RSV polymerase binding site and a pharmaceutically acceptable carrier, classified in class 435, subclass 235.1.

For Group VI above, restriction to one of the following is also required under 35 USC 121. Therefore, election is required of one of Groups I-VII, and, if Group VI is elected, then election is also required to one of inventions (VI-1)- (VI-6). These subgroups represent the vaccine of Group VI wherein:

- (VI-1) the *RSV genome* encodes a mutated *G gene*;
- (VI-2) the *RSV genome* encodes a mutated *L gene*;
- (VI-3) the *RSV genome* encodes a mutated *N gene*;
- (VI-4) the *RSV genome* encodes a mutated *M1 gene*;
- (VI-5) the *RSV genome* encodes a mutated *F gene*; and
- (VI-6) the *RSV genome* encodes a heterologous gene (*i.e. a gene not native to or derived from the strain of the RSV genome being modified*).

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachariah Lucas whose telephone number is 703-308-4240. The examiner can normally be reached on Monday-Friday, 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 703-308-4027. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
Z. Lucas  
Patent Examiner

  
James C. Housel 9/8/03  
JAMES HOUSEL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600